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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,938	08/21/2001	Pathiraja A. Gunatillake	1207.008US1	7489

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/933,938	GUNATILLAKE ET AL.	
	Examiner	Art Unit	
	Rabon Sergeant	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-79,81-108,111,112 and 117-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-79,81-108,111,112 and 117-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 20, 2004 has been entered.

2. Claim 68 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since two compounds that satisfy formula (I) have been set forth within claim 64, it is unclear which of the two compounds is being referred to by the language, "the compound of formula (I)", within claim 68.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 63-79, 81-108, 111, 112, and 117-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szycher et al. ('627) or WO 98/13405 or JP 4-248826, each in view of Li et al. ('724) and Ohtaki et al. ('085).

The primary references disclose the production of polysiloxane-polyurethane (urea) polymers having enhanced biocompatibility wherein active hydrogen group containing polysiloxanes are combined with additional active hydrogen compounds, such as polyethers or polycarbonates, and the resulting mixtures are reacted with polyisocyanates to yield polymers having enhanced characteristics. It is noted that Szycher et al. and JP 4-248826 disclose the use of hydroxyl functional polysiloxanes, as well as, amine functional polysiloxanes.

5. While none of the primary references disclose the specific use of an amine functional siloxane as a chain extender and WO 98/13405 fails to disclose the use of an amine functional siloxane soft segment, Li et al. specifically teach the use of amine functional polysiloxane compounds, which overlap applicants' claimed soft segment and hard segment compounds, in the production of biocompatible polyureas and polyurethane ureas having improved physical and mechanical properties. Furthermore, Ohtaki et al. disclose the use of amino functional tetraorganodisiloxanes as modifying reactants within polyurethanes.

6. Therefore, since applicants' claimed amine functional polysiloxanes were known reaction constituents for polyurethaneurea and since they were known to bestow improved properties, including improved biocompatibility, to urethanes, it would have been *prima facie* obvious to utilize them as reactants, such as chain extenders and/or soft segment reactants, within the compositions of the primary references, so as to arrive at the instant invention.

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7. Applicants' response of August 20, 2004 has been considered. Despite applicants' arguments, the position is maintained for the aforementioned reasons that the secondary references serve to render obvious the use of compounds that correspond to applicants' claimed hard and soft segment compounds as reactants for polyurethaneureas having improved properties. Applicants have failed to establish that the respective use of the claimed soft segment reactants and chain extenders yield an unexpected result, relative to the teachings of the relied upon references. Applicants' reference to the macrodiol compound of formula (I) within page 16 of the response is not understood, because the claims do not embody such a compound.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
September 13, 2004


RABON SERGENT
PRIMARY EXAMINER